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10/579,472	12/05/2006	Philipp Schaefer	290706US0PCT	3441
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
CHEVALIER, ALICIA ANN				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
07/09/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/579,472

**Applicant(s)**

SCHAEFER, PHILIPP

**Examiner**

ALICIA CHEVALIER

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 33-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-US)  
Paper No(s)/Mail Date 4/27/09 + 8/7/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-50 are pending in the application, claims 33-50 are withdrawn from consideration.
2. Amendments to the specification and the claims, filed on April 27, 2009, have been entered in the above-identified application.

***Election/Restrictions***

3. Applicant's election with traverse of Group I, claims 1-32, in the reply filed on April 27, 2009 is acknowledged. The traversal is on the ground(s) that the examiner has not provided any indication that the contents of the claims interpreted in light of the description was considered in making the assertion of lack of unity and therefore has not met the burden necessary to support the assertion. This is not found persuasive because the present application was filed on the national stage under 35 USC 371, the propriety of a restriction requirement or "unity of invention" is evaluated by the criterion stated in PCT Rule 13 (or, alternatively, in 37 CFR 1.475(a)), namely, unity of invention exists between multiple inventions only when these inventions share one or more "special technical features" in common with the understanding that these special technical features define a contribution which each of the inventions makes over the prior art. Evidence of lack of unity between the groups is found in the rejection, wherein it is found to disclose the features of instant claim 1. As such, the special technical features of the claimed invention are not found to define a contribution over the prior art.

The requirement is still deemed proper and is therefore made FINAL.

4. Claims 33-50 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on April 27, 2009.

### *Specification*

5. The disclosure is objected to because of the following informalities: the specification lacks section heads. See MPEP § 601 for the preferred form and content of an application.

### *Claim Rejections - 35 USC § 112*

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “suede type” in claim 1 is unclear and renders the claim vague and indefinite. The addition of the word “type” to an otherwise definite expression extends the scope of the expression so as to render it indefinite.

The term “polished grain side” in claim 1 is unclear and renders the claim vague and indefinite. It is unclear what “polished” means, e.g. will the side be polished smoothed to have a low surface roughness or just polished enough to great a high surface roughness.

The phrase “essentially having the same thickness both in the region of the grain tips as well as in the region of the grain valleys” in claim 1 is unclear and renders the claim vague and indefinite. It is unclear if the finish has grain tip and grain valley regions or if the backing on which the finish is produced has grain tip and grain valley regions. If it is the latter, it is also unclear what the resulting structure of the finishes would be, e.g. merely a surface roughness or a grooved surface.

Claim 1 recites the limitations “the region of the grain tips” and “the region of the grain valleys”. There is insufficient antecedent basis for this limitation in the claim.

The terms “essentially,” “polished” and “thin” in claim 1 is a relative term which renders the claim indefinite. The terms “essentially,” “polished” and “thin” are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The phrase “wherein the bonding layer has interruptions” in claim 6 is unclear and renders the claim vague and indefinite. It is unclear how the bonding layer is interrupted, e.g. by including different elements within or by being a discontinuous layer.

The term “weakened positions” in claim 8 is unclear and renders the claim vague and indefinite. It is unclear how the bonding layer is “weakened.”

The term “punctiform” in claim 8 is unclear and renders the claim vague and indefinite. It is unclear what structure or composition comprises a punctiform.

Claim 12 recites the limitations “the fiber tips” and “hollow spaces”. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites "wherein its upper side is formed fibrously, and that the bonding layer is arranged predominantly in the region of the fiber tips, so that between these hollow spaces, causing a pump effect, are kept free" which is unclear and renders the claim vague and indefinite. It is unclear if Applicant is claiming the method of applying the bonding layers to fibers or a fibrous structure.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 16 recites the broad recitation additives, and the claim also recites for example soft resins or soft polymers, in particular acrylates which is the narrower statement of the range/limitation.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Proctor (U.S. Patent No. 2,994,617).

Proctor discloses a substrate (*leather substitute, title*) comprising a finish (*coating, stage E of the figure, reference #12, and col. 4, line 47*) and bonding layer (*binder, stage E of the figure, reference #10, col. 4, line 46*). The finish is on the visible side of the substrate (*the figure*) and has a grain texture (*title and col. 7, lines 18-20*) and is deemed to have a polished grain side forming the upper side. The finish consists of a stabilized synthetic dispersion (*col. 4, lines 48-63*) and has through capillaries extending through the full thickness and essentially having the same thickness both in the region of the grain tips as well as the region of the grain valleys (*the figure and col. 5, line 41*). The bonding layer is formed of a stabilized synthetic dispersion containing polyurethane (*col. 3, line 30*) and is applied to the upper side of the substrate (*the figure*).

The limitation “a synthetic suede material with an upper side consisting of microfibers” is an optional limitations and does not need to be present to anticipate the claim 1.

The limitations “is produced on a backing with a textured surface corresponding to the gain texture” and “is bonded by way of a single thin bonding layer to the substrate” are method limitations and do not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner

could reasonably conclude that the claimed product differs in kind from those of the prior art.  
MPEP 2113.

The capillaries have different cross-sections, are arranged irregularly distributed, have a diameter between 0.005 mm and 0.05, extend substantially in a straight line and the finish has at least 100 capillaries (*col. 5, lines 56-73 and the figure*). The bonding layer has interruptions, weakened positions of reduced thickness, arranged only partially on the surface of the substrate, has a punctiform, screen or grid, has maximum thickness between 0.01-0.05 mm, weakened position thickness between 0.002-0.01 mm (*the figure and col. 4, lines 21-27*).

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wilson II, (U.S. Patent No. 2,771,995) and Steigerwald (U.S. Patent No. 3,695,988) also disclose similar imitation leather grain substrates.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alicia Chevalier/  
Primary Examiner, Art Unit 1794  
7/7/2009